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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,997	06/28/2005	Cheol-Su Lee	J323-053 US	9049
21706 7590 06/24/2009 NOTARO & MICHALOS P.C. 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100				
EXAMINER ANTONIENKO, DEBRA L				
ART UNIT 3689		PAPER NUMBER		
MAIL DATE 06/24/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/540,997

**Applicant(s)**

LEE, CHEOL-SU

**Examiner**

DEBRA ANTONIENKO

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2009 has been entered.

2. This is a Non-Final Office Action in response to communications received April 12, 2009, wherein:

Claim 1 has been amended;

Claims 2, 4, and 5 have been cancelled; and

Claims 1 and 3 are pending.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the second paragraph of Claim 1, the term "setting" is vague and indefinite. Also, in the third paragraph of Claim 1, the phrase "inputting the set" is vague and

indefinite. Does set mean the previously established codes or does it mean the pair of codes must be input together?

The term "character image" is vague and indefinite. As written in the second paragraph of Claim 1, it sounds like a character image is the third item on the certificate. As written in the sixth paragraph of Claim 1, it sounds like the character image is an image of the certificate, i.e. the character image will show the identification code and the secret code.

The term "secret code" is vague and indefinite. As written in the second paragraph of Claim 1, "a secret code for creating an electronic certificate" sounds like programming code, but in the third paragraph, it sounds like another identification code, but secret. Or is the secret code a private key?

The uniqueness of the identification code and/or the certificate is unclear as written in Claim 1. In the second paragraph, the phrase "by using audio visual tag or RFID tag for corresponding big-name brand goods" reads as if there is one identification code for one similar group of product, for example, all handbags of style xyz of big-name designer have the same identification code. In the third paragraph, the phrase "transmission of an electronic certificate for the goods" is unclear. Is this saying, for example, that all handbags of style xyz of big-name designer now have a certificate? Also, in the third paragraph, the phrase "only one electronic certificate can be created per goods" sounds like there is a typo in that goods should not be plural. However, if this is not a typo, then the uniqueness does not appear consistent.

In the third paragraph of Claim 1, the phrase "said one electronic certificate can only move after being created" is perplexing. It implies that the certificate can do something before being created, but nothing can do anything before being created.

In the sixth paragraph of Claim 1, as written, the phrase "authenticating... without... authenticating" is unclear. Is only a visual inspection of the display of the certificate necessary to authenticate?

In Claim 3, the phrase "transmitting results of the certification or authentication" is vague and indefinite. It is unclear what the result is. Is it a display of the certificate?

Examiner notes that *[a]n essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...* In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989).

5. Claim 1, second paragraph, recites the limitation "the big-name brand's identification code." There is insufficient antecedent basis for "identification code" in the claim. (A/an/the should correlate with the noun.)

Claim 1, second paragraph, recites the limitation "audio visual tag" and "RFID tag." There is insufficient antecedent basis for this limitation in the claim.

Claim 1, second paragraph, recites the limitation "first purchase." There is insufficient antecedent basis for this limitation in the claim.

Claim 1, third paragraph, recites the limitations "character image" and "manager program." There is insufficient antecedent basis for these limitations in the claim.

6. Examiner notes that if "confirming" is a significant step in the method claim, it should be written as such.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. As best interpreted in light of 35 USC 112, second paragraph, rejections noted above, Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miettinen et al., International Publication Number WO 01/54346 A1 (hereinafter referred to as Miettinen) in view of Coppersmith et al. U.S. Patent Number 6,996,543 B1 (hereinafter referred to as Coppersmith).

Regarding Claim 1, Miettinen teaches a method for servicing an electronic certificate setting and indicating an identification code (page 4, lines 34-37; base identity, first electronic identity); requesting creation and transmission of an electronic certificate (page 5, lines 1-5; id response, second electronic identity, second certificate) by inputting the identification code (identifier) into an electronic certificate server (identity

registration authority; page 9, lines 35-38; Certificate Authority CA server), said electronic certificate comprising the identification code, character image (Figure 3; Certificate ID), and management program (Figure 2; manages the flow of data); creating the electronic certificate after confirming the identification code, when the request for genuine quality certification is received (page 5, lines 8-13 and lines 24-27; digitally signs); transmitting the electronic certificate through a wire/wireless network (page 5, lines 16-21); and displaying the character image of the electronic certificate on a display apparatus (Figure 3)... so that possession can be shown and authenticating can be achieved even without the step of authenticating the goods (Figure 3; the user name shows direct ownership; the Passphrase Hash is for authentication).

That the electronic certificate will be used for *a big-name brand or genuine quality* verses any product or good does not serve to patentably distinguish the claimed invention over the prior art. In other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Miettinen does not disclose the use of a secret code along with the identification code. However, Coppersmith teaches wherein a secret code may be provided together with the identification code, in which the secret code (routing information) is able to be first open and known at the first distribution or the first purchase and the secret code being

inputted together with the identification code (serial number) for creating the electronic certificate (1), otherwise the secret code may be transmitted at the first distribution or the first purchase, the electronic certificate (1) comprising the secret code (column 5, lines 8-32; column 6, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to include more than one piece of information in the certificate in order to make authentication more precise.

Miettinen does not explicitly disclose using an audio or visual tag, or a RFID tag before the first distribution or the first purchase and checking it at the first distribution or the first purchase. Also, Miettinen does not explicitly disclose being constructed so that only one electronic certificate can be created per goods when being created and said one electronic certificate can only move after being created. However, Coppersmith discloses smart tags created by the manufacturer and then checked after purchase (column 3, lines 24-28; column 4, lines 23-39). Also, Coppersmith discloses generating a single serial number (column 4, lines 18-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Miettinen to include a tag in order to provide easy access to the certification information. Also, it would have been obvious to create only one serial number or certificate per product, otherwise multiple identification numbers would defeat the purpose. This is well known, for example, the VIN used for automobiles.



9. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Miettinen in view of Coppersmith and further in view of Anderson, U.S. Patent Application Number 2005/0257055 A1 (hereinafter referred to as Anderson).

Regarding Claim 3, Miettinen further teaches wherein a database for the electronic certificate is constructed by the electronic-certificate creation server at the time of creation and transmission of the electronic certificate (page 5, lines 31-37; Figure 1; it is obvious to store data when created, otherwise it can not be used or transmitted again).

Miettinen and Coppersmith do not explicitly disclose said method further comprising the steps of transmitting results of the certification or authentication as for the electronic certificate and/or information when certification or authentication is requested from the client through the authentication/management server, and achieving a change in ownership of the goods of the big-name brand or genuine quality by moving the electronic certificate to the client of a transferee together with transfer of the goods and cancelling the electronic certificate from the client of a transferor. However, Anderson discloses the ownership record can be recreated at any time by the network from internal resources in order to transmit to the device for authentication ([0021]-[0023]; Figure 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the capabilities to change ownership in order to further guard against theft.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 4:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DA

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689